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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,748	10/04/2000	Makoto Sakakibara	54030USA7A.0	3966

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3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

17

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 17

# Office Action Summary

Application No.

09/647,748

Applicant(s)

SAKAKIBARA, MAKOTO

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly added claim 6 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The length and compositions of short fiber are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

More particularly, it appears from the Specification (e.g., Example 1 at page 8 of Specification) that the length and compositions of the short fibers are the point of novelty, as otherwise the extremely broad claim reads upon the prior art.

#### ***Response to Amendment***

5. The Examiner wishes to note that in newly amended claims 1 and 2, Applicant attempted to further clarify the limitation of "the short fibers". However, it is noted that

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the improper transitional term "comprising" still fails to exclude the wood pulp fiber taught by Canary.

With respect to Applicant's Response arguing that "the Examiner has not put forth any prior references ..." (Response, page 3, 4<sup>th</sup> paragraph), the Examiner notes that in section 4 of Paper No. 4, the Examiner has clearly provided a reference by Canary as teaching a wood pulp has a fiber length between 2 and 5 mm, which reads on the instant claimed short fiber length within the range of about 3 to 20 mm. Further, the Examiner notes that it appears that the prior art reference is irrelevant to whether the Markush group is open or close ended.

6. Claims 1-3, 5 and newly added independent claim 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary, substantially for the reasons set forth in section 4 of Paper No. 14, section 5 of Paper No. 11, and section 4 of Paper No. 6, together with the following additional observations.

For the newly added independent claim 6, it is noted that Canary teaches that layer 1 generally has between about 10 and 40 wt. % polyolefin fibers; the fibrils of the polyethylene have an average length between about 0.6 and 1.2 mm and a maximum length of about 2.5 mm. Layer 1 also contains a softwood pulp fibers with an average length between about 2 and 5 mm. Further, layer 2 generally has between about 40 and 80 wt. % polyolefin (column 3, lines 49-60). In the absence of the fiber length in claim 6, the Examiner determines that the polyolefin fibers taught by Canary is "short fiber", i.e., shorter than pulp fibers. As such, Canary's teaching clearly reads on the

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limitation of the instant claimed invention as both layers having a blend of a polyolefin short fibers to wood pulp less than 50%.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
May 12, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-

1700

*Daniel Zinker*